

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/846,670	04/30/97	SORENSEN	J 18-106

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HM32/0508

EXAMINER

LEARY, L

ART UNIT	PAPER NUMBER
1623	3

DATE MAILED: 05/08/98

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No. <b>08/846,670</b>	Applicant(s) <b>Jens Ole Sorensen</b>
Examiner <b>Louise Leary</b>	Group Art Unit <b>1623</b>



Responsive to communication(s) filed on Sep 15, 1997.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

Claim(s) 1-40 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-40 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

LOUISE N. LEARY  
PRIMARY EXAMINER

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Claims 1-40 are pending in this application.

2. *OBJECTION:*

The abstract is objected to because (a) the abstract should be limited to a single paragraph; and (b) the abstract should avoid using the ambiguous phrase "A product including *such* a test-species component..." Correction is required.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-40 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a number of "test species", does not reasonably provide enablement for identifying or determining what class or classes of components of test species actually deleteriously affect members of a target species. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The disclosure provides enablement for a number of "test species" but does not reasonably provide enablement for identifying or determining what class or classes of components of test species actually deleteriously affect members of a target species. Specifically, the specification does not state whether the component to be identified is an organic or inorganic component; an intracellular or extracellular component, a peptide, a carbohydrate or a protein. In addition, there is no description of deleterious affect on members of a target species in the specification. Moreover, there is no claim limitation or method step describing the deleterious affect one skilled in the art must recognize to identify the component(s) of test species. Therefore, the scope of the claims is not commensurate with the scope of the enabling disclosure because the specification does not identify a class or classes of components of members of test species.

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4. Claims 1-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite because the metes and bounds of "components" intended to be represented by the phrases "test species" have not been described as claim limitations which renders the claims indefinite for not particularly point out and distinctly claim the subject matter which applicant regards as the invention. Alternatively, the claims are indefinite in the absence of a description of suitable "components" of members of test species that deleteriously affect members of a target species. Hence, "components" of members of test species that deleteriously affect members of a target species can not be determined from the claims. Correction is required to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1-40 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action.

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6. The Kaslow et al, Miller, and Judy et al references have been cited to further show the state of this art.

7. Any inquiry concerning this communication should be directed to Louise Leary at telephone number (703) 308-3533.

  
LOUISE N. LEARY  
PRIMARY EXAMINER

May 4, 1998